

REMARKS

Claims 1-20 are pending in the present application. Claim 13 has been canceled. Thus, upon entry of this amendment, claims 1-12 and 14-20 will be pending.

Rejection Under 35 USC § 103(a)

Claims 1-20 stand rejected under 35 U.S.C. 103(a) as being allegedly rendered obvious by U.S. Patent No. 6,153,238 to Shannon ("Shannon") in view of GB 2,237,224 to Craig; U.S. Patent No. 3,191,809 to Schultz; U.S. Patent No. 2,103,111 to Ekdahl; U.S. Patent No. 2,968,262 to Lacey; U.S. Patent No. 2,945,458 to Setecka; U.S. Patent No. 560,719 to Hueg and further in view of EP Patent No. 757006 to Ooms; FR Patent No. 598674 to Berrod; U.S. Patent No. 3,847,523 to Parrish; U.S. Patent No. 2,320,496 to Wechsler; U.S. Patent No. 4,844,917 to DeLorimere; U.S. Patent No. 2,419,654 to Moore; U.S. Patent 6,179,165 to Knight; and U.S. Patent Publication 2003/0205584 to Niggemyer. Applicants traverse this rejection.

The present claims recite an integrated coupler, i.e., a coupler that has a decorative opening designed to extrude filling in a decorative shape and that is attachable to a decorative tip for extruding filling in another decorative shape. Shannon describes a first embodiment having a decorator tip (see col. 4, ll. 13-22 and Fig. 1) and a second embodiment having an adaptor to allow for exchanging one decorator tip for another (see col. 6, ll. 48-65 and Figs. 5 and 6).

The Office Action acknowledges that Shannon does not disclose the use of an adaptor having a non-circular decorative opening. The Office Action imprecisely and misleadingly states that Shannon "does not disclose" whether or not Shannon's decorative, non-circular tip is attachable to another decorative tip. (Top of p. 3 of the Office Action). Rather, it is clear that Shannon does not contemplate the use of one decorative, non-circular tip attached to another. None of the figures showing a decorative, non-circular tip (i.e., element 40 or 145) demonstrates a means (such as threading) to attach one decorative, non-circular tip to another. Nor is there any description in the specification suggesting such a combination.

Shannon, which is primarily directed to a purportedly inventive cap, is merely a good summary of two embodiments of the prior art: (i) a permanent decorative, non-circular tip or (ii) an adaptor (coupler) for exchanging different non-circular decorative tips. Indeed, the Office Action cites many references that disclose one of these embodiments. What this demonstrates, however, is that the advantages and disadvantages of each embodiment was known, but heretofore no one had realized how to successfully combine these embodiments to achieve the superior product of the claimed invention.

The Office Action asserts that it would have been obvious to modify the coupler in Shannon by changing the shape of its opening from a circular opening to a non-circular decorative opening as an “obvious matter of design”. (Bottom of page 3 of the Office Action). Applicants respectfully disagree.

No Motivation to Modify Primary Reference

The use of a non-circular decorative opening runs counter to the intended purpose of Shannon’s coupler. The courts have held that there is no motivation to modify a reference when the suggested combination of references would require “a change in the basic principle under which the [primary reference] construction was designed to operate.” In re Ratti, 270 F. 2d 810, 813, 123 USPQ 349, 352 (CCPA 1959).

Shannon’s coupler, like all of the couplers in the cited art, shows a large circular opening. The primary purpose, if not the only purpose, of the opening of the couplers in the cited art is to provide a means for filling (such as icing) to flow from a bag, through the opening and through an attached decorative tip. The laws of physics with respect to resistance mandates the use of a large, circular opening to minimize resistance. The cited art all describe, in both words and figures, couplers having circular openings, indicating that the design of their couplers is dictated by the desired function of allowing filling to flow to a tip with a minimum amount of resistance. Nothing in any of the cited references suggests that the couplers could have non-circular openings.

The use of a non-circular decorative opening of the claimed invention necessarily increases the amount of resistance of the opening, thereby running counter to the intended

PATENT

Serial No.: 09/940,805

Docket #: 58880/278

purpose of the couplers of the prior art. Thus, there is no motivation for one of ordinary skill in the art to modify the circular openings of the prior art couplers to a non-circular decorative shape, let alone the dentate protrusions recited in some of the claims.

Moreover, even if one of skill in the art had considered modifying the circular opening, there would not have been a reasonable expectation of successfully achieving a non-circular decorative opening capable of providing a decorative shape while retaining its primary purpose of allowing filling to flow to an attached decorative tip with a minimal amount of resistance. The lack of a reasonable expectation of success is most apparent for those claims that recite dentate protrusions.


For the foregoing reasons, Applicants respectfully request that obviousness rejection under 35 USC 103(a) be withdrawn.

CONCLUSION

It is respectfully submitted that the present application is now in condition for allowance, as all outstanding issues have been addressed. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of the subject application.

Respectfully submitted,
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Dated: 3/29/06


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